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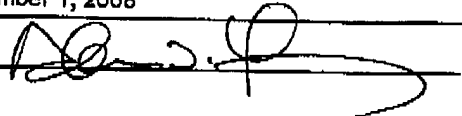
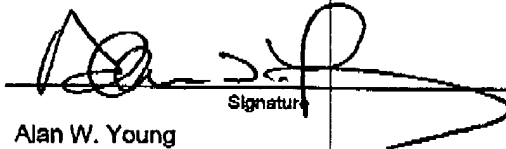
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PTO/SB/33 (08-08)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) ORCL5643DIV (OID-1999-180-01-DIV)	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>September 1, 2008</u> Signature  Typed or printed name <u>Alan W. Young</u>		Application Number <u>10/759,318</u>	Filed <u>January 16, 2004</u>
		First Named Inventor <u>Editt GONEN-FRIEDMAN</u>	
		Art Unit <u>3691</u>	Examiner <u>Chuks N ONYEZIA</u>
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>37,970</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		 Signature <u>Alan W. Young</u> Typed or printed name <u>650-851-7210</u> Telephone number <u>September 1, 2008</u> Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
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This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.8. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of

Editt GONEN-FRIEDMAN et al.

For: **METHODS AND SYSTEMS FOR
ONLINE SELF-SERVICE
RECEIVABLES AND AUTOMATED
ONLINE RECEIVABLES DISPUTE
RESOLUTION**

Serial No.: 10/759,318

Filed: January 16, 2004

) Examiner: Chuks N ONYEZIA

) Group Art Unit: 3691

) Confirmation No.: 8350

) Customer No.: 22430

) **PRE-APPEAL BRIEF REQUEST FOR
REVIEW**

) Attorney Docket No.: ORCL5643DIV

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CERTIFICATE OF FACSIMILE TRANSMISSION UNDER 37 CFR §1.8

I hereby certify that this document and the documents referred to herein are being transmitted by facsimile to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, at 371-273-8300, on **September 1, 2008**.


Alan W. Young

MAIL STOP AF

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

Dear Sir:

Applicants respectfully request Pre-Appeal Brief Review of the outstanding §103(a) rejections which, it is submitted, are predicated upon clear factual errors in the Office's characterization of the applied references.

The Office, in the context of its §103(a) rejection, re-submits the previously overcome (§102(e)) rejections relative to Cross, and now asserts that the only difference between Cross and the claimed embodiments is that Cross "does not explicitly disclose that the dispute process is conducted through the vendor's Web site.", a feature the Office contends is taught by Robinson et al.

An examination of Cross reveals that the Office's position is unsupported by the reference itself. Indeed, Cross teaches to:

1. upload a vendor bill(10 in Fig. 1);
2. carry out a validation process on the uploaded bill (see Col. 2, lines 25-27);
3. generate discrepancy information and a dispute report according to the results of the validation process if the charged rates do not match reference rates (see Col. 2, lines 45-55);
4. determine whether the uploaded bill should be approved or disapproved through a bill review and approval process (see Col. 2, lines 59-63), and
5. carry out one of three steps; namely:
 - a. approve and pay the invoice (see Col. 11, lines 34-35)
 - b. reject the invoice and mark the invoice as rejected (see Col. 11, lines 40-41), or
 - c. short pay the invoice and send a dispute report to the vendor (see Col. 22, lines 36-38).

As may be seen, after the customer obtains the bill from the vendor (i.e., after the customer uploads the vendor bill), the vendor is no longer involved in the dispute process, until the customer provides the vendor with a dispute report.

Clear Error I: No pending Credit Memo Request is created by the customer and caused to be routed to the vendor in Cross, contrary to that asserted by the Office.

In Cross, the uploaded invoice is paid, rejected, or partially paid, and no pending Credit Memo Request is created by the customer and/or caused by the customer to be routed through the vendor (the entity in Cross that generates the invoice), contrary to what is asserted by the Office. The dispute resolution in Cross is carried out solely by the customer – which is possible in Cross because the balance of power in Cross, as between the vendor (local, small telecom) and the customer (long distance, large telecom), rests with the customer, the larger of the two entities. In fact, as noted in the previously filed Amendment, Cross teaches that the customer is in contact with the vendor on only three occasions, none of which being for the purpose of requesting a Credit Memo:

1. One connection is made to the external data source 10 to access and upload the invoice (see Col. 4, lines 59-60);
2. One connection is made through the autopayment interface 13 when the invoice is paid (see Col. 5, lines 1-10), and
3. One last connection is made through an invoice and dispute report output to provide copies of invoices and dispute reports to the vendor.

All of the other steps and processes described in Cross are carried out internally within the customer. That is, the customer does not carry out a step of “*accessing, by the customer, a database record corresponding to the pending invoice to be disputed over a Web site of the vendor*”, as claimed. Nor does the customer carry out the claimed step of “*selecting, from the vendor’s Web site, a reason code for the dispute along with an identification of a disputed amount in the pending invoice*”. Cross does not teach such steps as Cross teaches that the customer obtains the invoice from the vendor and thereafter carries out all steps internally until it pays the invoice and/or provides a dispute report (the outcome of the dispute is a “*fait accompli*”, at this point) to the vendor. That the Office maintains otherwise constitutes a clear factual error.

Clear Error II: Reason codes are not selected from vendor’s Web site in Cross, contrary to that asserted by the Office.

The Reason Codes in Cross (see, e.g., Fig. 8, and reason code 40 in Col. 9, lines 10-13 of Cross) are the customer’s internal reason codes, and are not selected by the customer from the vendor’s Web site, as required by the claimed embodiments. Indeed, Cross teaches to approve, disapprove or short pay an

invoice internally, within itself, and does not teach or suggest any manner of one party requesting, and the other party generating, a Credit Memo Request or selecting any reason codes from a vendor's web site. The Office's contrary position is unsupported by Cross, and constitutes yet another factual error.

Clear Error III: Cross does not teach that the customer causes the Credit Memo Request to be sent through any process of the vendor, as claimed. This constitutes another clear factual error.

As pointed out previously, the pending claims recite that the Credit Memo Request is created through the vendor's Web site by the customer, which is antithetical to the method espoused by Cross, in which the customer (invoice recipient) does not: i) access the vendor's Web site; ii) select a reason code from the vendor's Web site, iii) validate a Credit Memo Request; or iv) cause any Credit Memo Request to be sent and routed to the vendor in the claimed (or any) manner. That the Office contends otherwise constitutes another factual error. In Cross, the "dispute resolution" is initiated, carried out and decided, *sua sponte*, entirely within, by and under the full control of the customer, and the vendor (the party that generated the bill) is a wholly uninvolved bystander in the process.

Indeed, it is respectfully submitted to the Review Panel that the discrepancy information and the dispute report taught by Cross is not equivalent to the claimed Credit Memo Request, nor are the claimed steps to create the claimed Credit Memo Request taught in Cross; whether carried out through the vendor's Web site or not. In Cross, the dispute report is generated within the customer (not through the vendor's web site), without any contact with the vendor, and merely sent to the vendor when the customer short pays the vendor (see Col. 11, lines 36-39). For this reason, Cross cannot be said to teach that the dispute report is routed through "*at least one of a selected process of the vendor for the selected reason code, a selected hierarchy of persons at the vendor empowered to approve Credit Memo Request incorporating the selected reason code and a primary approver at the vendor for the selected reason code,*" as required by the claims. The Office's contention otherwise constitutes yet another factual error.

For the foregoing reasons, therefore, it is respectfully submitted that the primary reference of the applied combination does not teach or suggest that which is again asserted by the Office. Previously, the Office changed the anticipation rejection to an obviousness rejection and added the secondary reference to Robinson et al. for its alleged teaching of the dispute process being "conducted thru the vendor's Web site".

Clear Error IV: The dispute process is not conducted "thru the vendor's Web site" in the secondary reference to Robinson et al., contrary to that asserted by the Office

Robinson et al. teach methods and systems for creating an encrypted digital receipt (see, e.g., the title and the Abstract of Robinson et al). The focus of Robinson et al. is to provide private records of an

online transaction that may be trusted by both parties (see Col. 2, lines 7-13). To provide "private records" that may be trusted by both the merchant and the customer, Robinson et al. teaches the generation of encrypted receipts for online transactions. To do so, a transaction record is generated that contains "at least some information that, on its face, would identify the transaction to the merchant" (see Col. 4, lines 45-47). This transaction record is then encrypted (see Col. 5, lines 12-17) to generate an encrypted "digital receipt" (their terminology), which is then transmitted back to the customer (see Col. 6, lines 23-25). The customer then saves this encrypted digital receipt (see Col. 6, lines 48-50), and may then use it "in case of disputes or problems with the order," (see Col. 6, lines 61-64). The customer, it is disclosed (at Col. 8, lines 31-35), "may wish to present" the digital receipt to the merchant when there is a dispute or whenever the customer or the merchant wishes to verify that a particular transaction took place or to verify that the customer is entitled to discounts. Robinson et al.'s encrypted digital receipt, therefore, is but a mutually acceptable proof-of-purchase receipt or certificate.

Nowhere, however, do Robinson et al. teach or suggest that "the dispute process is conducted thru the vendor's Web site" as asserted by the Office on page 4 of the outstanding Office Action, which constitutes another clear factual error on the Office's part. Robinson et al. teaches a trusted digital receipt that may be used as a trusted record of a past online transaction in cases in which a dispute arises. Robinson et al. are entirely silent as to any self-service method for a customer to dispute a pending invoice through the vendor's web site. Being issued an encrypted digital receipt as mutually-acceptable proof-of-purchase of a past (i. e., concluded) transaction in case of a later dispute does not rise to the level of a method for a customer to dispute a pending (as claimed) invoice through the vendor's web site. In fact, Robinson et al. are entirely silent as to how a customer dispute is to be processed, other than their repeated teachings that their encrypted digital receipt should be saved by the customer so that he or she may present it to the merchant should a dispute arises at some point in the future.

Considering now the Cross and Robinson et al. references in combination, as in proper in the context of a §103(a) rejection, the combination appears to teach, as set out in Cross, to upload a vendor bill; to carry out a validation process on the uploaded bill; to generate discrepancy information and a dispute report according to the results of the validation process if the charged rates do not match reference rates, and to carry out one of three steps; namely a) approve and pay the invoice (see Cross, Col. 11, lines 34-35), b) reject the invoice and mark the invoice as rejected (see Cross, Col. 11, lines 40-41), or c) short pay the invoice and send a dispute report to the vendor (see Cross, Col. 22, lines 36-38).

The encrypted digital receipt of Robinson et al., in Cross, would only be useful when the customer short pays the vendor's invoice and sends a dispute report to the vendor, as in 3) immediately above.

Indeed, according to the applied combination of references, the customer could then provide the saved encrypted digital invoice back to the vendor, as proof that the customer purchased the goods or services identified in the short-paid invoice, as taught by Robinson et al. The applied combination, therefore, cannot be said to teach or suggest the claimed embodiments, nor would the claimed embodiments somehow "emerge" from a collective consideration of these two references.

The Final Office Action repeats the rejections of the November 13, 2007 Office Action verbatim and offers only two arguments in the "Response to Arguments" section, both of which are factually flawed and do not, in any event, further advance the prosecution of this application.

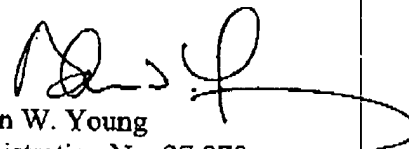
Clear Error V: The "Examiner interprets such a change in billing status as a credit memo request". Page 8 of Office Action of 06/27/08. A change in billing status is the anticipated result of a credit memo request. The instrument (the Credit Memo Request) that initiates the dispute resolution is not the same as the anticipated result thereof. The Office's interpretation constitutes yet another clear factual error and does not support the outstanding §103(a) rejections.

Clear Error VI: "...by employing the system of cross [sic, Cross] for dispute resolution, the customer is carrying out the underlying processes performed by Cross." Page 9 of Office Action of 06/27/08. This statement is, at the very least circular (by employing the system of Cross, the customer is carrying out the process of Cross) and also does not support the outstanding §103(a) rejections.

For the foregoing reasons, therefore, it is respectfully requested that the 35 U.S.C. §103(a) rejections applied to the claims be reconsidered and withdrawn and that the Review Panel direct the Examiner to allow this application. The same is, therefore, respectfully requested.

Respectfully submitted,

Date: September 1, 2008

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